

APR. 13. 2005 3:01PM

NO. 1421 P. 1

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### FACSIMILE COVER SHEET

DATE: April 13, 2005

TO: Examiner Robert A. Madsen, Group Art Unit 1761

Fax No.: (571) 273-1402

Confirmation No. 9482

FROM: Michael R. Davis 

Number of pages being transmitted, including this cover sheet: 7

Please direct all questions concerning the transmittal of these pages to Patricia T. Hill.

RE: Serial No. 09/492,137 (Takayuki WATANABE et al. ), filed January 27, 2000

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#### MESSAGE:

Confirming our telephone conversation of today, I am enclosing a copy of the Response to Advisory Action filed March 7, 2005, together with a copy of the postcard receipt. I understand that the PTO system shows receipt of the Petition for Extension of Time and Notice of Appeal, both of which were also filed March 7, 2005.

Thank you for your attention to this matter.

#### CONFIDENTIALITY NOTICE

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COPY

**ATTY DOCKET #:** 2000-0044A  
**Confirmation No.** 9482

**Due Date:** March 8, 2005

**OUR REF:** 2000-0044A/MRD/00202

**Applicant:** Takayuki WATANABE et al.

**Serial No.:** 09/492,137

**Filing Date:** January 27, 2000

**Title:** EDIBLE POWDER MATERIAL HAVING EXCELLENT SHELF STABILITY

**Receipt of the following papers is acknowledged:**

PTO Fee Transmittal Form

Petition for third month Extension of Time including PTO fee of \$570.00

Notice of Appeal including PTO fee of \$500.00

Response to Advisory Action

Check in the amount of \$1,070.00 to cover all PTO fees indicated above



**Date:** March 7, 2005

**Attorney:** MRD/pth

**[Check No.]** 62004 1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 9482  
Takayuki WATANABE et al. : Docket No. 2000-0044A  
Serial No. 09/492,137 : Group Art Unit 1761  
Filed January 27, 2000 : Examiner Robert A. Madsen

EDIBLE POWDER MATERIAL

HAVING EXCELLENT SHELF STABILITY : Mail Stop AF

THE COMMISSIONER IS AUTHORIZED  
TO CHARGE ANY DEFICIENCY IN THE  
FEE FOR THIS PAPER TO DEPOSIT  
ACCOUNT NO. 23-0975.

RESPONSE TO ADVISORY ACTION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE UNDER 37. CFR 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 1761

Sir:

This is in response to the Advisory Action mailed February 23, 2005.

Substance of Interview

On March 3, 2005 Applicants' attorney contacted Examiner Madsen by telephone and indicated that it was Applicants' intention to respond, on the merits, to the Advisory Action mailed February 23, 2005. Applicants' attorney inquired about the possibility of obtaining the Examiner's reaction to the response by the statutory deadline for noting the appeal, which is March 8, 2005, if the response is filed in the PTO on March 4, 2005 (to perhaps avoid filing an Appeal). The Examiner indicated that, in view of the scanning process now in effect in the PTO, this would be unlikely.

Applicants' attorney also raised the question of whether or not the Examiner is still maintaining his position that it is necessary to compare the present invention with a combination of the references, instead of individual references. The Examiner indicated consideration of Rule

132 Declarations is undertaken on a "case by case" basis, and referred Applicants' attorney to MPEP 2145, and specifically *Ex parte Obiaya*, 227 USPQ 58, 60 cited therein.

Response on the Merits

Initially, Applicants note that contrary to item 7 on page 1, and item 1 on page 2 of the Advisory Action, the claims in the application are claims 1-4, 6, 8, 10, 12 and 13 as set forth on pages 2-3 of the Amendment After Final Rejection filed February 7, 2005, considering that the Advisory Action indicates that the Amendment has been entered.

In item 4 beginning on page 2 of the Advisory Action, the Examiner takes the position that the Declaration "shows a powder comprising 16% trehalose and 16% hemicellulose" which is not the claimed subject matter, since the claimed subject matter is to a powder composition with 25-85% trehalose and 5-60% hemicellulose.

The Examiner seems to consider that, in Table I at page 2 of the Declaration (filed June 7, 2004), the proportion of the amount of hemicellulose (400 parts) and trehalose (400 parts) to the total amount (2500 parts) gives the content of hemicellulose (16%) and trehalose (16 %).

However, the "total amount" in Table I is not the amount of "powder", but is the amount of emulsion which contains a large amount of "water". As mentioned in the Declaration, page 2, lines 7-10, the emulsion is spray-dried to make lemon or paprika powder.

The following tables show the content of each component such as hemicellulose and trehalose in the finally obtained spray-dried lemon or paprika. Incidentally, although most of the water evaporates by spray-drying, a very small amount of water remains in the powder.

(Composition after drying)

Lemon oil

Sample No.	1	2	3	4	5	6	7
Water-soluble hemicellulose	38.8 %	38.8 %	38.8 %	38.8%			
Pullulan					38.8%		
Gum arabic						38.8%	
Gelatin							38.8%
Trehalose	38.8%				38.8%	38.8%	38.8%
Erythritol		38.8%					
Dextrin			38.8%				
Maltitol				38.8%			
Lemon oil	17.5%	17.5%	17.5%	17.5%	17.5%	17.5%	17.5%
Water contents	4.9%	4.9%	4.9%	4.9%	4.9%	4.9%	4.9%

Paprika oil

Sample No.	1	2	3	4	5	6	7
Water-soluble hemicellulose	38.1 %	38.1 %	38.1 %	38.1%			
Pullulan					38.1%		
Gum arabic						38.1%	
Gelatin							38.1%
Trehalose	38.1%				38.1%	38.1%	38.1%
Erythritol		38.1%					
Dextrin			38.1%				
Maltitol				38.1%			
Paprika oil	19.0%	19.0%	19.0%	19.0%	19.0%	19.0%	19.0%
Water contents	4.8%	4.8%	4.8%	4.8%	4.8%	4.8%	4.8%

Considering the above tables, the content of each of trehalose and hemicellulose in the resultant lemon powder is 38.8 %, and the content of each of trehalose and hemicellulose in the resultant paprika powder is 38.1 %, both of which fall within the range 25-85 % trehalose and 5-60% hemicellulose as defined in claim 1 of the present application, respectively.

Accordingly, contrary to the position taken by the Examiner in item 4 beginning on page 2 of the Advisory Action, the Declaration does in fact compare the present invention as claimed with the references.

#### MPEP 2145 and *Ex parte Obiaya*

Referring to the telephone discussion with the Examiner as noted above, Applicants point out that this case law and section of the MPEP (page 2100-159, right column) under which the case law is cited, are concerned with recognition of another (different) advantage, or latent properties, which would flow naturally from the prior art. On the other hand, Applicants' Declaration is not presented for this purpose, but rather, is presented to show an improvement in a property (storage stability) of the composition of the claimed invention as compared to the prior art. Attention in this regard is directed to MPEP 716.02(a), and particularly section II which indicates that superiority of a property shared with the prior art is evidence of nonobviousness. The superiority of the presently claimed composition compared to the prior art references, in terms of storage stability, has been thoroughly discussed on the present record; and Applicants again respectfully point out (as noted in the first paragraph on page 5 of the Amendment After Final Rejection filed February 7, 2005) that the Examiner expressed agreement during the interview that the Declaration does show superior results as compared to the applied prior art references.

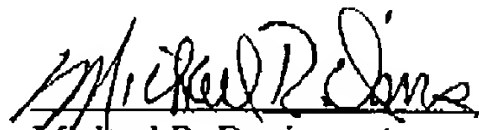
#### Conclusion

The Declaration shows unexpected superior results for the presently claimed invention as compared to the prior art references, thus overcoming any presumption of obvious which may have been established based on the references.

Accordingly, the application is considered to be in condition for allowance, and such allowance is solicited.

Respectfully submitted,

Takayuki WATANABE et al.

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March 7, 2005